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10/525,513	05/19/2005	Alberto Laghi	4017-30	7882
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,513

**Applicant(s)**

LAGHI ET AL.

**Examiner**

PAUL R. FISHER

**Art Unit**

3689

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 2/24/2005

### **DETAILED ACTION**

1. This is a first Office Action Non-Final rejection on the merits. Preliminary amendment has been received on February 24, 2005, canceling claims 1-14 and adding claims 15-29. Claims 15-29 are currently pending and have been considered below.

#### ***Claim Objections***

2. Claim 15 objected to because of the following informalities: line 3 of claim 15 recites the term "organising" which appears to be a misspelling of the word --organizing--.

- . Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 15, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

6. In claim 15, the recited term "a product", in line 5 of claim 15, renders the claim indefinite. It is unclear to the Examiner if this is the same product mentioned in line 2 or a new product.

7. In claim 15, the recited term "addressing to consult", renders the claim indefinite. It is unclear to the Examiner what is meant by this limitation. Is this the web address or

something else? For purposes of examination the Examiner is reading this to mean the web address is listed.

8. Regarding claim 17, the phrase "or similar element" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or similar element "), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

9. Regarding claims 21-26 and 28, the phrase "or equivalent wordings" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or equivalent wordings"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 15-19 and 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Coult (US 2002/0035571 A1) hereafter Coult.**

**As per claim 15**, Coult discloses a method for communicating and controlling data, for example information data concerning intellectual property rights pertaining to a product (Page 2, paragraphs [0033], [0035], [0037]; which disclose that the invention is

directed toward the collection, control and communicating of information which pertains to a product and its intellectual property rights), the method comprising the steps of

organizing a list of data defined by at least an alphanumeric code that identifies the existence of intellectual property rights for protecting a product (Page 9, paragraph [0123]; discloses that the data, in this case patent numbers, is organized and stored on a web site), and

making available said list by publishing on an Internet site (Page 9, paragraph [0123] and Page 10 paragraph [0124]; disclose that the website is made public so that others may view the list of patents for that product) and

associating with said product an informative note that refers to existence of said intellectual property rights and contains instructions for addressing to consult said Internet site (Page 9, paragraph [0123] through page 10, paragraph [0125]; disclose that the public is referenced to the website in order to learn about the patents being held by that particular product).

**As per claim 16**, Coult discloses the above-enclosed invention, Coult further discloses wherein said list is made available by displaying the list on at least one web page of said Internet site (Page 9, paragraph [0123] through page 10, paragraph [0125]; disclose that the public is referenced to the website in order to learn about the patents being held by that particular product),

said note further containing instructions for accessing said page of said Internet site (Page 10, paragraph [0124]; discloses that the product has a URL or web address

which has instructions to obtain the patent number(s) of the product or product part or feature which is of interest).

**As per claim 17**, Coult discloses the above-enclosed invention, Coult further discloses enabling said list to be displayed (Page 2, paragraph [0037]; discloses that the public would be directed to a website at which point they would be directed toward the numbers of the patents which apply to the manufacturer's many products, including the product so inscribed).

Coult further discloses wherein said Internet site displays at least one activating button (Page 9 of the applicant's specification discloses that an activating button, or similar element, enabled direct access to said web page and therefore to the direct display of said data list, from this the Examiner asserts that any element that enables access to the data list would meet this requirement), or similar element, the activation of which enables said list to be displayed (Page 11, paragraphs [0137] – [0139]; disclose that the web page has a graphical user interface or GUI which guides the user to the information desired which as read by the Examiner is equivalent to an activating button since it enables direct access to the data list).

**As per claim 18**, Coult discloses the above-enclosed invention, Coult further discloses wherein said activating button displays at least an inscription or wording referring to the commercial name and/or the model and/or the type of said product (As described above the activating button is equivalent to any element that enables direct access to the data list, Page 11, paragraphs [0138] and [0139]; disclose that the user is

presented with a graphical user interface and that along with the patent numbers they would also be given the bibliographical data).

**As per claim 19**, Coult discloses the above-enclosed invention, Coult further discloses wherein said activating button is displayed on the introductive display or on the home page of said Internet site (As described above the activating button is equivalent to any element that enables direct access to the data list, Page 11, paragraphs [0138] and [0139]; disclose that the user is presented a website with a graphical user interface).

**As per claims 21-24**, Coult discloses the above-enclosed invention, Coult further discloses wherein said alphanumeric code univocally identifies at least one number of patent application or a number of granted patent (Page 11, paragraphs [0137]-[0139]); said information note supporting an inscription or wording of the type: "For patent information on this product, please consult the Internet site [www.x.y](http://www.x.y)" or equivalent wording (Page 11, paragraph [0137]; discloses that the URL is presented in a manner such as "For patent marking data, see [www.patentmarking.com](http://www.patentmarking.com)" which is equivalent).

The Examiner notes that while Coult does discloses similar wording as suggested by the claim, this wording in itself is considered to be non-functional descriptive material since it fails to change, alter or limit the steps of the method in anyway.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim

limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

**As per claims 25 and 26**, Coult discloses the above-enclosed invention, Coult further discloses wherein said activating button displays an inscription or wording of the type "Patents" or equivalent wordings (As described above the activating button is equivalent to any element that enables direct access to the data list, Page 11, paragraphs [0138] and [0139]; disclose that the user is presented a website with a graphical user interface, since the graphical user interface guides the user it would have equivalent wordings).

Wherein said list is made available preceded by an explicative comment of the type "The present product is protected by one or more of the following patent



applications/patents." Or equivalent wordings (Page 11, paragraphs [0138] and [0139]; disclose that the user is presented a website with a graphical user interface, since the graphical user interface guides the user it would have equivalent wordings).

The Examiner notes that while Coult does disclose similar wording as suggested by the claim, this wording in itself is considered to be non-functional descriptive material since it fails to change, alter or limit the steps of the method in anyway.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and

will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 20 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coult (US 2002/0035571 A1) hereafter Coult.**

**As per claim 20**, Coult discloses the above-enclosed invention, Coult further discloses that the website could be the client's or manufacturers own website (Page 11, paragraph [0144])

Coult fails to explicitly disclose wherein said Internet site is the official site of the Company that produces and/or deals and/or advertises said product.

However, the Examiner asserts that it would have been obvious to one of ordinary skill at the time of the invention that a company or manufacturers website is the official website of the Company. Which can be seen by companies like Dell, whose website [www.dell.com](http://www.dell.com) in the company's official site.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the method of Coult, the fact that the

manufacturer's website is considered to be the official website of the company, since that is often the case for many manufacturers.

**As per claim 27**, Coult discloses the above-enclosed invention, Coult further discloses said informative note being reproduced on a plaque suitable for being fixed on at least a visible zone of the external structure of said machine (Page 2, paragraph [0035] and Page 8, paragraph [0104]; discloses that when the product is being manufactured a label is created for that product so that anyone who uses the product will know what patents cover that product).

Coult fails to explicitly disclose that the product comprises an automatic machine, or portions thereof, operating in the field of packaging articles in general.

However, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made that Coult's method could be applied to any product, since it is not limited in the specification in anyway to any particular type of product. Since Coult's method could be used to label any product it would obviously include an automatic machine, or portions thereof, operating in the field of packaging articles in general.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the method of Coult that the product being labeled is an automatic machine, or portions thereof, operating in the field of packaging articles in general since any product can be labeled Coult's method.

The Examiner notes that while Coult does disclose products, but the specific product itself is considered to be non-functional descriptive material since it fails to change, alter or limit the steps of the method in anyway.

**As per claim 28**, Coult discloses the above-enclosed invention, Coult further discloses an alphanumeric code that univocally identifies at least a number (Page 11, paragraphs [0137]-[0139]).

informative note carry inscription or wording (Page 11, paragraph [0137]; discloses that the URL is presented in a manner such as "For patent marking data, see [www.patentmarking.com](http://www.patentmarking.com)" which is equivalent).

Coult further discloses storing information regarding trademarks (Page 5, paragraph [0063]).

Coult fails to explicitly disclose wherein the alphanumeric code identifies a trademark.

However, the Examiner asserts it would have been obvious to one having ordinary skill in the art at the time of the invention that the method of Coult could be applied to trademarks as well as patents since they are both considered to be intellectual property and are both used to related what rights are held by the manufacturer of that product. Since Coult does data regarding the trademark it would have been obvious that that data could also be used when producing the label.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the method of Coult, the use of trademarks as well as patents since both are intellectual property and are both used to

relate what rights are held by the manufacturer of that product. Since Coult does data regarding the trademark it would have been obvious that that data could also be used when producing the label.

**As per claim 29**, Coult discloses the above-enclosed invention, Coult further discloses further comprising the step of controlling and updating said list of data by means of an editing operation by means of which said identifying alphanumeric codes of said list are modified or substituted and the step of making immediately available said list by communicating again said list on said internet site (Page 5, paragraph [0073]; discloses the information is updated either manually or automatically).

Coult fails to disclose that the updating takes place at fixed intervals of time.

However, the Examiner asserts that it would have been obvious to one having ordinary skill in the art in the field of intellectual property, for instance the US Patent and Trademark Office updates the newly issued patents every Tuesday. Further it is known that patents already have a fixed time period associated with them and, thus when the patent term expires the patent information will be updated.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the method of Coult, updating the information in fixed time intervals since it would ensure that the information stayed up to date. This being important since it will ensure that no information is missed by the public concerning patent rights.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
January 31, 2009

